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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,091	09/04/2003	James J. LeKachman	47004.000216	5822
21967 7590 07/24/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109				
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TRAN, HAI				
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3694				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/654,091

**Applicant(s)**

LEKACHMAN, JAMES J.

**Examiner**

HAI TRAN

**Art Unit**

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This is the communication in response to Applicant's Request for Continued Examination and Remarks filed on June 12, 2008 for application, titled: "System and Method for Financial Instrument Pre-Qualification and Offering".
2. Claims 1, 12, 14, and 31 have been amended. Accordingly, claims 1-31 are pending and have been examined.

***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 12, 2008 has been entered.

***Priority***

4. This application claims the benefit of U.S. Provisional Patent Application No. 60/407,696, filed on 09/04/2002.

***Drawings Objection***

5. Applicant has amended figures 1 and 2. Hence, the objection is withdrawn.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz et al. (U.S. Patent No. 6,055,573) ("Gardenswartz").

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

9. **Regarding Claim 14**, Gardenswartz discloses a method for offering financial instruments to pre-qualified consumers, comprising:

receiving information related to personal identification information associated with a consumer who is a customer of a financial institution or an entity associated with the financial institution, the consumer personal identification information being transmitted

prior to a consumer contact (see Figure 5/elements 500, 502; col. 10, lines 3-9, Figures 6, 7 and description);

inquiring a third party based on the received information related to the consumer personal identification information whether the consumer has been pre-qualified for a financial instrument, the financial instrument associated with the financial institution (see Figure 5/element 504; col.10, lines 16-23, Figure 8 and description); and

offering the consumer the financial instrument for which he or she is pre-qualified, if the third party confirms that the consumer is pre-qualified for a financial instrument (see Figure 5/element 506, col. 10, lines 23-34, Figure 9 and description),

wherein the third party maintains consumer information relating to consumer pre-qualification for financial instruments (see Figure 1/element 8; col. 5, lines 61—4 of col. 6), wherein further the standards for the consumer pre-qualification are set by the financial institution (see Figure 1/elements 2, 4, 6, 16, 18; col. 6, lines 63-24 col. 7).

Gardenswartz discloses a system and method for delivering targeted advertisement to a consumer based on his offline purchase history (col. 2, lines 58-61) wherein an advertisement is a "value contract" (reward, see col. 3, lines 61-63). Gardenswartz teaches pre-qualifying a consumer for a value contract based his demonstrated purchase history behavior (col. 3, lines 5-17), but does not explicitly teach pre-qualifying a consumer for a financial instrument by checking his credit rating. Gardenswartz teaches all elements and limitations as disclosed in the claim except the different product (value contract vs. financial instrument) and the pre-qualification information (purchased history data vs. credit rating). Therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention to modify Gardenswartz's system to include the financial instrument product and credit rating checking to offer consumer with different products.

10. **Regarding Claim 15**, Gardenswartz teaches the method of claim 14, wherein pre-qualification of the consumer comprises checking at least one of the credit rating of the consumer, the income level of the consumer, the debt level of the consumer and the payment history of the consumer with the financial institution (see col.3, lines 8-11, 46-59, col. 15, lines 19-40, figure 10/element 1000. Examiner notes that this is equivalent to checking the credit rating of a consumer).

11. **Regarding Claim 16**, Gardenswartz teaches the method of claim 15, wherein pre-qualification of the consumer occurs prior to receipt of the consumer personal identification information (see Figure 5/element 504, 506, col. 10, lines 16-34 where consumers are classified and delivered targeted advertisements before they contact the stores).

12. **Regarding Claims 17-18**, Gardenswartz teaches wherein the third party maintains consumer information in files indexed by a unique identifier, and wherein the unique identifier relates to the personal identification information of the consumer (see col. 3, lines 18-44, col. 5, lines 44-60).

13. **Regarding Claim 19**, Gardenswartz teaches the method of claim 18, further comprising offering the financial instrument to the consumer only if the consumer credit rating meets or exceeds a pre-determined condition (see col. 3, lines 5-17, 46-60).

14. **Regarding Claims 20-21**, Gardenswartz teaches wherein the financial instrument comprises any financial instrument for which credit information relating to the consumer is predictive, and wherein the financial instrument comprises at least one of a car loan, boat loan, loan on investment property, margin account, business loan, second mortgage, home equity line of credit, consumer loan, transaction card, credit card, loyalty card, co-branded credit card, debit card, rewards card, smart card, mutual fund or insurance (see col. 14, lines 50-3 of col. 15).
15. **Regarding Claim 22**, Brody teaches the method of claim 21, wherein the consumer is offered the financial instrument only if one or more pre-determined conditions are met (see col. 3, lines 46-60).
16. **Regarding Claims 23-25**, Gardenswartz teaches wherein the consumer personal identification information is obtained when the consumer makes contact comprises a purchase from a merchant (see col. 15, lines 8-18), wherein the consumer personal identification information is obtained through contact comprises one of a communication from a business partner of the financial institution or a communication directly to the financial institution (see col. 5, lines 44-60), and wherein consumer personal identification information is obtained through a telephone call or contact over a computer network (see col. 4, lines 26-44, col. 5, lines 32-42).
17. **Regarding Claim 26**, Gardenswartz teaches the method of claim 25, further comprising offering the financial instrument only upon the acceptance of any terms and conditions related to the financial instrument by the consumer (see col. 3, lines 61-12 of col. 4).

18. **Regarding Claim 27**, Gardenswartz teaches the method of claim 25, further comprising offering the financial instrument to the consumer only if the identity of the consumer is authenticated (see col. 3, lines 32-44, col. 5, lines 44-60).

19. **Regarding Claims 28-29**, Gardenswartz teaches wherein authenticating the consumer comprises favorable comparison of stored consumer information to consumer personal identification information, and wherein the consumer personal identification information comprises at least one of a calling telephone number, a PIN, a password, a biometric or any other information known or held by the consumer and generally not known to the public that can be used to authenticate the consumer (see col. 3, lines 32-44, col. 4, lines 26-44, col. 5, lines 44-60).

20. **Regarding Claim 30**, Gardenswartz teaches the method of claim 28, wherein authentication is performed by the third party (see col. 3, lines 36-44).

21. **Regarding Claim 31**, this claim is similar to claim 14 except that includes the limitation of "wherein further the financial instrument comprises any financial instrument for which credit information relating to the consumer is predictive" (see discussion in claim 20-21 above).

22. **Regarding Claims 1-13**, these are the computer system claims including the necessary apparatus, programs, and processors for implementing the method claims 14-31 and have the same limitations. Hence, they are rejected under the same rationale provided in claims 14-31.



***Conclusion***

23. Claims 1-31 are rejected.
24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAI TRAN whose telephone number is (571)272-7364. The examiner can normally be reached on M-F, 9-4 PM.
25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. T./  
Examiner, Art Unit 3694

/James P Trammell/  
Supervisory Patent Examiner, Art Unit 3694

